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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IKON Office Solutions, Inc.

Serial No. 75/002,162

Nancy Rubner-Frandsen, Michael F. Snyder and Camille M.
Miller of Seidel Gonda Lavorgna & Monaco, P.C. for IKON
Office Solutions, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 103 (Mike Szoke, Managing Attorney).

Before Simms, Cissel and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Alco Standard Corporation, an Ohio corporation, has
filed an application for registration of the mark
"INTERNATIONAL OFFICE SYSTEMS" for "distributorship
services in the field of office equipment," in
International Class 35, and for "maintenance and repair

services in the field of office equipment," in International Class 37.¹

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that if applicant's proposed mark were used in connection with these services in the field of office equipment, it would be merely descriptive of applicant's services.

Applicant has appealed the refusal to register based upon the alleged merely descriptive nature of the mark. Briefs have been filed, but applicant did not request an oral hearing.

A mark is unregistrable under Section 2(e)(1) of the Trademark Act as merely descriptive of the services with which it is used if it immediately and forthwith conveys information about the characteristics, features or functions of those services. See In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987), and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Accordingly, the Trademark Examining Attorney contends that the wording "INTERNATIONAL OFFICE SYSTEMS"

¹ Serial number 75/002,162, filed October 5, 1995, based upon an allegation of a *bona fide* intention to use the mark in commerce. The records of the U.S. Patent and Trademark Office reflect the fact that applicant recorded its name change of

immediately tells potential purchasers that applicant will "... provide services pertaining to office systems on an international basis." (Trademark Examining Attorney's brief, p. 4). Evidence placed in the record by the Trademark Examining Attorney demonstrates the use of this phrase, or its variations, in ways that make this point:

'Continued weakness in our *international office systems* and supplies business affected Nashua's third-quarter results,' said Charles Clough, chairman and CEO... "Nashua Corp. Profits Off in Quarter," *The Manchester Union Leader*, October 19, 1989.

Created by Borrelli and fellow San Diego furniture designer Fred Gemmell, the "Tech Desk" *office system* emphasizes ergonomics and maximizes space..."

"Desk has interesting twist on computer monitor display," *San Diego Union Tribune*, April 19, 1996.

GTE will spring for *office systems* and equipment only when it doesn't duplicate what employees use at work...

"Working at Home - The right way to be a star..." *Fortune Magazine*, March 3, 1997.

Wang, a maker of *office systems* equipment, agreed earlier this year to acquire Bull's U.S. operations and several subsidiaries...

"The Ticker," *The Chicago Sun Times*, April 3, 1995.

These stories taken together demonstrate the recognition within the business press that there exists an industry categorized as "office systems." Further,

January 1997 to "IKON Office Solutions, Inc.," at Reel 1825,

although its computerized listing of trademark applications or registrations (Exhibit A to applicant's reply brief) was submitted too late to be made a part of the record, under Rule 2.142(d), nonetheless we note that in most of the marks applicant listed therein, the combined term "Office Systems" is consistently disclaimed within composite marks. This view into the trademark data base of the U.S. Patent and Trademark Office clearly supports the position of the Trademark Examining Attorney that this matter is highly descriptive of computerized equipment, ergonomic systems furniture and other equipment designed to save space, increase capacity and provide a more efficient office working environment.

If one simply takes the ordinary meanings of each of these words from the dictionary entries and evaluates them in the context of the overall composite, it also supports the Trademark Examining Attorney's refusal. When viewing these three words as a unitary phrase, it takes no imagination to know exactly what this describes, namely, that these services for office systems and equipment are available internationally. Other large companies around the world likely assume, with good reason, that they could freely use such descriptive terms to designate an

international operation providing products and services in the field of office systems and equipment. In fact, the LEXIS/NEXIS entries demonstrate that other companies have indeed done so.

Applicant argues that the Trademark Examining Attorney has improperly dissected this composite mark, and that the addition of the word "international" to "office systems" tips the scales in favor of registration. However, we see nothing in the joining of the word "international" with the term "office systems" that creates a new or different meaning than one would anticipate when melding these individual components. The word "international" would convey information immediately to the potential purchaser that these services would be available in a number of countries around the globe.²

Certainly, there are examples of where common, ordinary words can be combined in a novel or unique way and thereby achieve a degree of protection denied to words when used separately. However, in adopting this specific formulation, applicant has not created any new double or incongruous meaning for the combined phrase. In short, the

² As with applicant's Exhibit A, *supra*, although Exhibits C and D to applicant's reply brief were submitted too late to be made a part of the record, under Rule 2.142(d), we note that the terms "International," "International Business," and "International Systems," are also consistently disclaimed.

term "international office systems" does not require imagination, thought and perception to reach a conclusion as to the nature of the services and therefore it cannot be considered a suggestive term. Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990) [Term "THE PROFESSIONAL PORTFOLIO SYSTEM" is merely descriptive of computer-based portfolio valuation systems]; BankAmerica Corporation et al. v. International Travelers Cheque Company, 205 USPQ 1233 (TTAB 1979) [Applicant's use of the word "INTERNATIONAL" in the term "INTERNATIONAL TRAVELERS CHEQUE" does not differ from the manner in which that word is commonly used by others (e.g., activities, transactions or relationships between different nations or residents of different nations or persons traveling between different nations), and inasmuch as applicant's services are international in scope, the addition of the word "INTERNATIONAL" to "TRAVELERS CHEQUE" merely describes applicant's financial consulting services concerning travelers checks and bank drafts]; and National Fidelity Life Insurance v. National Insurance Trust, 199 USPQ 691 (TTAB 1978) ["NATIONAL INSURANCE TRUST" is merely descriptive of insurance trust services which are nationwide in scope].

Accordingly, we find that the Trademark Examining Attorney herein has more than adequately demonstrated that this term is merely descriptive of the services specified in this application.

Decision: We affirm the refusal of the Trademark Examining Attorney to register this matter under Section 2(e)(1) of the Act.

R. L. Simms

R. F. Cissel

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial and
Appeal Board